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Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/669,869 09/21/00 WILDER

T DAREDEV.018R

EXAMINER

PM82/1004

KNOBBE MARTENS OLSON & BEAR  
620 NEWPORT CENTER DRIVE  
SIXTEENTH FLOOR  
NEWPORT BEACH CA 92660-8016

MAR, M

ART UNIT

PAPER NUMBER

8

3619

DATE MAILED:

10/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/669,869</b>	Applicant(s) <b>Thomas V. Wilder et al</b>	Examiner <b>Michael Mar</b>	Art Unit <b>3619</b>	
	-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --				
<b>Period for Reply</b>					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>Three</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.					
- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.					
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.					
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.					
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).					
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).					
<b>Status</b>					
1) <input type="checkbox"/> Responsive to communication(s) filed on _____					
2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.					
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.					
<b>Disposition of Claims</b>					
4) <input checked="" type="checkbox"/> Claim(s) <u>1-13 and 16-28</u> is/are pending in the application.					
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.					
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.					
6) <input checked="" type="checkbox"/> Claim(s) <u>1-13 and 16-28</u> is/are rejected.					
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.					
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.					
<b>Application Papers</b>					
9) <input type="checkbox"/> The specification is objected to by the Examiner.					
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.					
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.					
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.					
<b>Priority under 35 U.S.C. § 119</b>					
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).					
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:					
1. <input type="checkbox"/> Certified copies of the priority documents have been received.					
2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.					
3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).					
*See the attached detailed Office action for a list of the certified copies not received.					
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).					
<b>Attachment(s)</b>					
15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)			18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)			19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>7</u>			20) <input type="checkbox"/> Other: _____		

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## **DETAILED ACTION**

### ***Reissue Applications***

1. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
  
2. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
  
3. Claims 13 and 16-28 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the

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meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 5 of '369 patent recites: "one or more web members extending between". Reissued claim 13 recites: "at least one cross-member extending between". Recitations which included the recitation "one or more web members extending between" were added to claim 5 to overcome the rejection during the prosecution of the '369 patent. Since the term "cross-member" is considered broader than the term "web", the substitution of this term in the reissued claim would constitute recapture of subject matter previously surrendered.

Claim 5 of '369 patent recites: "in an upwardly extending direction above said one or more web member". Reissued claim 13 recites: "in an upwardly extending direction". Since the recitation "in an upwardly extending direction above said one or more web member" was added to claim 5 during the prosecution of the '369 patent, the omission of the portion "above said one or more web member" in the reissued claim would constitute recapture of subject matter previously surrendered.

Claim 5 of '369 patent recites in line 6: "a pair of laterally spaced longitudinal members". Reissued claim 13 recites in line 4: "a pair of elongate, spaced apart members". The recitation "laterally spaced" which was added to claim 5 during the prosecution of the '369 patent.

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Since the recitation “spaced apart” is considered broader than the term “laterally spaced”, the substitution of this term in the reissued claim would constitute recapture of subject matter previously surrendered.

Claim 5 of ‘369 patent recites: “one or more web members extending between”. Reissued claim 22 recites: “at least one cross-member extending between”. Recitations which included the recitation “one or more web members extending between” were added to claim 5 to overcome the rejection during the prosecution of the ‘369 patent. Since the term “cross-member” is considered broader than the term “web”, the substitution of this term in the reissued claim would constitute recapture of subject matter previously surrendered.

4. The reissue oath/declaration filed with this application is defective because it fails to identify the errors in the ‘369 patent which are relied upon to support the reissue application with respect to claims 22-28 presented in the preliminary amendment filed April 30, 2001.

See 37 CFR 1.175(a)(1) and MPEP § 1414.

5. Claims 1-13 and 16-28 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

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**6. Any response to this action should be mailed to:**

Assistant Commissioner for Patents

Washington, D.C. 20231

**or faxed to:**

(703) 308-2571

(for formal communications intended be entered)

(all informal communications should be labeled "PROPOSED" OR "DRAFT")

**or hand delivered to:**

Crystal Park 5, 2451 Crystal Drive, Arlington, Virginia 22202

Seventh Floor(receptionist)

**6. Any inquiry concerning this communication should be directed to Michael Mar at telephone number (703) 308-2087.**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*Michael Mar*  
**MICHAEL MAR**  
**Primary Examiner**

M.Mar

Sept. 27, 2001